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In re Application of
Marrero Miragaya et al.
Application No.: 10/540,296
PCT No.: PCT/CU03/00020
Int. Filing Date: 22 December 2003
Priority Date: 27 December 2002
Attorney Docket No.: 976-28 PCT/US
For: Formulations For The Rectal Administration
Of Thrombolytically-Active Agents

DECISION
ON
PETITION

This is in response to the petition under 37 CFR 1.47(a) filed on 20 January 2006.

BACKGROUND

This international application was filed on 22 December 2003, claimed an earlier priority date of 27 December 2002, and designated the United States. The International Bureau transmitted a copy of the published international application to the USPTO on 15 July 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 27 June 2005. Applicants filed *inter alia* the basic national fee on 21 June 2005.

On 22 December 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the \$200.00 petition fee is being charged to petitioner's Deposit Account No. 08-2461, as authorized by the "Response To Notification Of Missing Requirements..." filed on 20 January 2006.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Milea Yeni Sarmiento Mayea be excused because she "could not be found." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is

therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

The petition states that the "pertinent facts are recounted in the accompanying 'Declaration' signed by Dr. Sonia Gonzalez Blanco." In her Declaration, Dr. Gonzalez Blanco (hereinafter, "Blanco") states that she sent a letter to Milesa Yeni Sarmiento Mayea (hereinafter, "Mayea") at her last known address, requesting her appearance at the Patents Department of the Genetic Engineering and Biotechnology Center to execute a declaration, but that the letter subsequently was returned by the Cuban Postal Service with markings indicating that Ms. Mayea had "Moved, Left No Forwarding Address." Dr. Blanco further states that she conducted an internet search "using the Google search engine" to perform a search "in English" for "Milesa Yeni Sarmiento," but that the search "did not locate Milesa Yeni Sarmiento."

It is not clear from the record whether any further efforts were made to locate Ms. Mayea and, if not, why not. For instance, was a search performed using the "Mayea" portion of her name? Was a search performed using Spanish as the operative language, or using a different search engine? Was a telephone directory search performed? Were inquiries made of any neighbors, known associates or appropriate civil authorities who may have been aware of Ms. Mayea's whereabouts? Were any electronic communications (e.g., telephone calls or e-mails) attempted? In the absence of a complete showing of what efforts were undertaken to ascertain the whereabouts of Ms. Mayea, it would not be appropriate to conclude that she "could not be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition includes a statement the last known address of Milesa Yeni Sarmiento Mayea. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the petition is accompanied by a declaration document signed by joint inventors Marrero Miragaya, Aguilera Barreto, Gonzalez Chavez, Martinez Diaz, Torrez Cabrera, Cosme Diaz, Hernandez Marrero and Tamargo Santos on behalf of themselves and non-signing joint inventor Sarmiento Mayea. However, further inspection reveals that the published international application nominates "Cosme Diaz, Carelia" as an inventor, whereas the declaration nominates "Karelia Cosme Diaz." The record appears to include no explanation of this discrepancy. In the absence of a suitable explanation and/or showing concerning this discrepancy, it would be inappropriate to conclude that the declaration filed on 20 January 2006 satisfies requirement (4). *See* MPEP 605.04(b) and 201.03(b).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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